

REMARKS

I. Status of Claims

Claims 1-118 are pending in this application. Claims 1-66, 70-101, and 104-118 have been rejected, and claims 67-69, 102, and 103 have been objected to. No claim has been amended herein.

II. Information Disclosure Statement

Applicants submit herewith an Information Disclosure Statement and PTO Form 1449. Applicants note that the Examiner has not yet initialed the citation of the Revlon Colorstay® product label disclosed in an Information Disclosure Statement Applicants filed on June 19, 2001. For the Examiner's convenience, Applicants have re-submitted the Revlon Colorstay® product label with the Information Disclosure Statement filed herewith, and respectfully request the Examiner consider this document and initial it on as having been considered.

III. Rejection under 35 U.S.C. § 112

The Examiner has maintained the rejection of the claims 16, 31, 50, 65, 85, 99, and 118 under 35 U.S.C. § 112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard as the invention. In doing so, the Examiner states that "the expression 'derivatives of any of the for[e]going' is without metes and bounds," [Office Action at 2], and "there are many functional groups in any given molecule and once the compound is derivatized the functional property changes." *Id.* at 3. Thus, according to the Examiner, because Applicants did not expressly recite specific derivatives in the specification, "the metes

and bounds of this term cannot be determined [from] the disclosure.” *Id.* Applicants respectfully disagree.

As Applicants have previously noted on the record, the claims themselves are not limited to any particular functional group of the derivatives (and certainly not towards a “functional property”), but rather are directed towards any and all of the derivative compounds as a whole. The Examiner herself demonstrates that the metes and bounds of the claimed derivatives are definite within the standard of 35 U.S.C. § 112, as evidence by the statement that “there are many functional groups in any given molecule and once the compound is derivatized the functional property changes.” *Id.* at 3. Despite relating it to a “functional property,” the Examiner has demonstrated a clear understanding of the term “derivative,” as it is indeed a common and comprehensible term to those of ordinary skill in the art.

Moreover, the Examiner’s assertion that there are many functional groups within a given molecule is not proper grounds for rejecting a claim under 35 U.S.C. § 112. Mere breadth of the claim, i.e., the fact that there are many possible functional groups in any given molecule, is not to be equated with definiteness. M.P.E.P. § 2173.04.

The term “derivative” itself has been repeatedly defined on the record as “[a] compound derived from or obtained from another and containing the essential elements of the parent substance.” The Examiner has not established that those of ordinary skill in the art would not understand what is being claimed when the claim is read in light of the specification. Reconsideration of the rejection is respectfully requested, as one of ordinary skill in the art would be able to discern the boundaries of what constitutes

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infringement of the claims containing the term "derivative." Thus the test for definiteness has been met. M.P.E.P. § 2173.

IV. Rejection under 35 U.S.C. § 103

The Examiner has maintained the rejection of the claims 1-66, 70-101, and 104-118 have been rejected under 35 U.S.C. § 103 over the combination of JP Abstract 5025019 (the '019 Abstract), U.S. Patent No. 5,959,009 to Konik et al. (Konik), and U.S. Patent No. 5,756,082 to Cashin et al. (Cashin).

According to the Examiner, Konik and Cashin teach "components 2-3 in a cosmetic composition," e.g., a film former other than polymethylsilsesquioxane and various additives. Office Action at 4. The Examiner admits, however, that neither Konik nor Cashin teaches polymethylsilsesquioxane, as recited in part (a) of claim 1. The Examiner then attempts to rectify this deficiency with the '019 Abstract, stating that "the abstract teaches polymethyl silsesquioxanes in cosmetic compositions," and "the polymer has high water and oil repellency." *Id.* Thus the Examiner concludes one of ordinary skill in the art would have found it obvious to prepare the claimed composition by combining Konik or Cashin with the '019 Abstract, in part because "the motivation to use the polymethyl silsesquioxanes in the compositions stems from the teachings of the abstract that this polymer used in the cosmetic material has high resistance to water." *Id.*

In maintaining this rejection, the Examiner further states that "the features upon which applicant relies (i.e. the structures on pages 12-13 which are the film formers claimed in the instant application) are not recited in the rejected claim(s)." *Id.* at 5.

Applicants, however, respectfully disagree.

In order to establish a *prima facie* case of obviousness, the Examiner must demonstrate, among other things, some suggestion or motivation to modify the reference and to combine reference teachings and that the prior art reference or references teach or suggest all of the claim limitations. M.P.E.P. § 2143. Contrary to the Examiner's assertion that the features relied upon are not recited in the instant claims, Applicants point out that claim 1 is directed in part towards "at least one polymethylsilsesquioxane film former comprising repeating units of $(\text{CH}_3\text{SiO}_{3/2})_x \dots$ " See Claim 1 (emphasis added). The claim is not, as the Examiner suggests, limited to the structures disclosed on pages 12 and 13 of the instant specification. Instead, the claim is directed to a composition comprising a polymethylsilsesquioxane film former. As it has not been shown that the '019 Abstract, or any of the cited references for that matter, teaches polymethylsilsesquioxane as a film former, no *prima facie* case of obviousness has been established. M.P.E.P. § 2143.

In fact, the '019 Abstract teaches that the polymethylsilsesquioxane disclosed therein "has high water-and-oil repellency." This statement coupled with the teaching on page 11 of the instant specification that certain polymethylsilsesquioxane "are highly insoluble and therefore are not film formers according to the present invention," make it clear that the references do not teach or suggest all of the claim elements, such as the element that the polymethylsilsesquioxane be a film former.

Even assuming *arguendo* that the polymethylsilsesquioxane of the '019 Abstract is a film former, the Examiner has still failed to establish any suggestion or motivation in the references or in the knowledge generally available to those skilled in the art to

combine reference teachings and certainly not to obtain the claimed invention. Specifically, the '019 Abstract teaches away from combining the disclosed polymethylsilsesquioxane having "high water-and-oil repellency" with the compositions of Konik or Cashin. Both Konik and Cashin require the presence of oils. Konik requires a volatile oil (see col. 1, I. 38), and Cashin requires a hydrocarbon oil (see col. 1, II. 36-37). Yet the polymethylsilsesquioxane of the '019 Abstract repels oil. Thus, making the combination that the Examiner suggests is "obvious" would necessitate one of ordinary skill in the art to add an *oil repellent* compound to an *oil*. One of ordinary skill in the art would certainly be lead away from making such a combination.

For at least these reasons, no *prima facie* case of obviousness has been established, and thus Applicants respectfully request withdrawal of the rejection.

V. Conclusion


In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 
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